

Application No. 10/677,694
Docket No. IB-8 (A4-1770)
Reply dated April 9, 2009
In response to Office Action of February 9, 2009

REMARKS

As of the filing of the present Office Action, claims 1-14, 17-31, 33-40, 44, 48-58, 62, 65, and 67-72 were pending in the above-identified US Patent Application. Claim 31 has been allowed.

The "Detailed Action" section of the Office Action does not set forth any prior art rejections. The only issues raised in the Office Action are a new matter objection under 35 USC §132, giving rise to a rejection of claims 1-14, 17-30, 33-40, 44, 48-58, 62, 65, and 67-72 under 35 USC §112, first paragraph. The Office Action then states at page 6

It is noted that an assessment of the prior art with respect to claims rejected under 35 U.S.C. 112, 1st paragraph was indeed included.

. . .

No statement of allowability is being given at this time for claims 1-14, 17-30, 33-40, 44, 48-58, 62, 65, and 67-72 in light of the rejection under 35 U.S.C. 112, 1st paragraph set forth above. Upon resolution of the 112 issues, the prior art will be revisited.

Applicants respectfully note that these statements are contradictory. If the claims were evaluated for obviousness under 35 USC 103 pursuant to MPEP

§2143.03, with all limitations of the claims considered and given weight (including limitations which do not find support in the specification as originally filed), then there would be no need for the prior art to be revisited after resolution of the §112 issues. In nearly twenty years of prosecuting patent applications, the undersigned's experience has been that, in similar situations, U.S. patent examiners will clearly state that the claims are unpatentable over the prior art of record, or that the claims appear to recite allowable subject matter though the new matter issue must yet be overcome.

By not making a statement as to the patentability of claims 1-14, 17-30, 33-40, 44, 48-58, 62, 65, and 67-72, the Office Action also fails to comply with MPEP §707.07 (entitled "Completeness and Clarity of Examiner's Action") and 37 CFR §1.104 (entitled "Nature of examination), which provides

(b) Completeness of examiner's action. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable. (Emphasis added.)

If the statement that “the prior art will be revisited” is understood to mean that “[u]pon resolution of the 112 issues” an additional prior art search will be conducted with respect to the combination of a reader unit and powering unit (said to be lacking support in the specification), then Rule 104(b) has clearly not been complied with because, in order to be “complete as to all matters,” such a search should have been conducted prior to issuing this final rejection.

Because the Examiner has made this rejection final, Applicants’ next response is severely limited to an amendment that “merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner.” 37 CFR 1.116(b). Applicants would be able to provide such a response if they knew whether any prior art rejections must yet be overcome. In effect, the statement that “[u]pon resolution of the 112 issues, the prior art will be revisited” is illusory, as the Examiner would not be obligated to re-open examination if the §§112 and 132 issues were decided in Applicants’ favor.

The Office Action also fails to comply with §MPEP 706.07, because the Office Action does not rebut Applicants’ assertion that “independent claims 1 and 2 and their remaining dependent claims are allowable over the prior art

of record.” Page 28 of the Reply filed October 9, 2008.

Finally, revisiting the prior art in a later office action instead of the present office action results in piecemeal examination, contrary to MPEP §707.07(g).

For the above reasons, it is improper for the present Office Action to omit a complete examination of all of the claims for patentability over the best available prior art, and such an omission unfairly denies Applicants an opportunity to fully prepare a complete reply with arguments in support of the patentability of their claimed invention over the prior art.

Applicants therefore respectfully request withdrawal of the present Office Action, restart of the period for reply under MPEP §710.06, and the filing of an Office Action that is “complete as to all matters,” including addressing the patentability of all claims pending in the application in view of the best available prior art.

§132 Objection and §112 Rejection

Though Applicants respectfully believe the present Office Action is incomplete, Applicants will take this opportunity to address the Examiner’s

arguments for maintaining the §132 objection and §112 rejection, which appear to focus on the use of indefinite or definite articles (“an” or “the”). If the Examiner reviews the application as-filed, she will note that the specification and claims contained numerous informalities, including improper uses of “an” and “the,” arising from the fact that Applicants prepared and filed their application *pro se*. For example, the “reader device 202” of Figure 3 is originally introduced at page 7, but then is later referred to as “the external reader 202,” “the reader 202,” “the reader” (without any reference number), “the reader device” (without any reference number), and even “an external reader” (using the indefinite article “an” and without any reference number) - all in specific reference to the embodiment of Figure 3. See pages 7 through 9. Therefore, the Examiner cannot rely on Applicants’ use of the article “an” or “the” to decide whether reference is being made to a new or different reader, because it is entirely consistent within the specification to later refer to the reader device 202 as “an intermediate reader unit” or “an external reader” as done on page 11.

The Examiner analyzed the use of “an” and “the” in the first paragraph of page 11 without taking into account the preceding paragraph

bridging pages 10 and 11, which states that the embodiments on page 11 are “[i]n addition to the basic implant-and-reader system [and] can be realized to achieve additional functionality” (emphasis added). The Examiner then separately analyzed this sentence, concluding that “in addition” and “additional functionality” do not mean “additional features,” but instead mean “alternative embodiments.” In other words, “addition” and “additional” do not mean “additional,” but mean “alternative.” So in this instance, where Applicants chose the correct term (“additional”), the Examiner applied a different meaning even though, simply put, if the reader device 202 is eliminated from these other embodiments, then these other embodiments would actually have alternative functionalities, and not the additional functionalities as taught by Applicants.

If the Examiner believes a Rule 132 affidavit explaining the above would be helpful or necessary to promptly resolve this dispute, Applicants will willingly do so. However, Applicants respectfully believe that a fair and reasonable interpretation is that each embodiment described on page 11 of the specification includes a reader unit in view of the totality of the evidence and for consistency with the remainder of Applicants’ disclosure.

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The evidentiary standard to be used throughout ex parte examination in setting forth a rejection is a preponderance of the totality of the evidence under consideration.

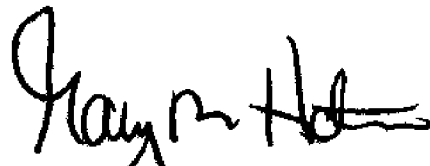
MPEP 2107.02 III.A., citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The undersigned wishes to close by asking that the above not be viewed as merely argumentative. Instead, it is the undersigned's effort and intent to bring the prosecution of this application to a prompt close, consistent with Applicants' best interests and with genuine and due respect for Examiner Mallari's consideration and thoroughness shown throughout the examination of this application.

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Should the Examiner have any questions with respect to any matter
now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gary M. Hartman", with a stylized flourish at the end.

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